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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,311	11/27/2001	James R. Shay	021737-001410US	.3014

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EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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2167

MAIL DATE	DELIVERY MODE
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01/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/997,311

Applicant(s)

SHAY ET AL.

Examiner

Luke S. Wassum

Art Unit

2167

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

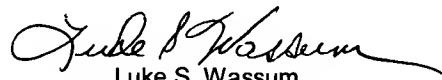
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): Rejection of claim 8 under 35 USC § 112.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5, 7, 8, 10-14 and 17-37.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


Luke S. Wassum
Primary Examiner
Art Unit 2167

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicants present arguments that the prior art of record, either individually or in combination, fails to disclose

- * locking one or more electronic documents in response to a first signal indicating the documents are ready to file; or
- * converting electronic documents into a locked image file in response to a second signal indicating filing of the documents.

The examiner respectfully disagrees, and believes that the applicants fail to appreciate the degree to which the principal prior art references are analogous to each other.

The Horikawa et al. reference teaches a system for managing patent documents and electronically submitting them to the patent office. It has been admitted on the record that the reference does not explicitly disclose either locking the documents or converting them to locked image files.

The Cautley et al. reference teaches a system for managing and submitting proposals. This system is analogous to that disclosed in the Horikawa et al. reference, in that both systems store and manage documents, and both systems allow those documents to be electronically submitted to some authority which will analyze the submitted documents and provide some kind of feedback as to the suitability of the documents.

In both situations, the feedback received may require the user to make additional changes to the submitted documents and resubmit them. In both cases, it is important that a copy of the 'as-submitted' documents be maintained, so that the feedback received can be interpreted and acted upon correctly. It is for this reason that the document locking feature disclosed by the Cautley et al. reference would have been an obvious addition to the patent document management system disclosed by the Horikawa et al. reference.

With regards to the 'in response to a first signal...' limitation, the Horikawa et al. reference discloses a first signal indicating that documents are ready to be submitted to the patent office (see page 28, lines 14-16), while the Cautley et al. reference discloses the analogous signal "When the proposal is formally submitted, the system notes the submission and freezes the proposal parameters" (see paragraph [0043], lines 1-3). In the system that would result from the incorporation of the document locking feature of the Cautley et al. reference into the patent document management system disclosed by the Horikawa et al. reference, the document locking would be in response to the first signal indicating that the documents are ready for submission to the patent office, as claimed.

Similarly, the conversion of the documents into a locked image file is disclosed by the Britton reference at col. 2, line 53 through col. 3, line 9. The advantages of such a conversion for files being transmitted electronically are taught as well. The Horikawa et al. reference and the Britton reference are analogous with regard to the feature being borrowed from the secondary reference (conversion of documents to locked image files), in that both references are concerned with the electronic transmission of documents over a network. As such, an ordinary artisan would have been motivated to incorporate the conversion of the electronic documents into locked image files as taught by the Britton reference into the patent document management system taught by the Horikawa et al. reference.

Again, similar to the above discussion, the incorporation of the file conversion feature into the patent document management system would result in a system wherein electronic documents are converted into locked image files in response to a second signal, as claimed.

The examiner also notes that a significant amount of the Applicants' arguments are directed to individual references and what they do not teach. In response, the examiner points out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The rejections of record are maintained by the examiner.